

Docket No. F-8984

Ser. No. 10/566,533

**REMARKS**

Claims 1, 2, 4, 5, 15, 17 and 19-22 remain pending in this application. Claims 1-5 and 15-19 are rejected. Claim 22 is cancelled herein without prejudice. Claims 3, 6-14, 16 and 18 are previously cancelled.

Applicants herein traverse and respectfully request reconsideration of the rejection of the claims cited in the above-referenced Office Action.

Claim 22 is rejected under 35 U.S.C. § 112, first paragraph, for allegedly containing subject matter lacking an adequate written description in the specification. Claim 22 is also rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject of the invention. Both rejections are based upon use of the term "transfer-contact." While applicants remain in disagreement with the Examiner's position, claim 22 is cancelled herein without prejudice, thereby rendering the rejections of claim 22 moot.

Claims 1, 2, 5, 17 and 19-22 are rejected as obvious over Lang (US 4,994,053) in view of Packard et al. (US 4,851,069) under 35 U.S.C. § 103(a).

It is respectfully submitted that a *prima facie* case of obviousness is not established in the present instance. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or

Docket No. F-8984

Ser. No. 10/566,533

to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP §706.02(j) "Contents of a 35 U.S.C. §103 Rejection".

Applicants respectfully submit that neither Lang nor Packard et al. teaches or suggests the claimed feature of "shifting the base sheet being held on a receiving and transferring roller face" of present claims 1 and 20, and therefore the proffered combination of references fails to disclosed all claim limitations, as properly required for establishing a *prima facie* case of obviousness.

In the Office Action, the Examiner avers that a receiving web 12/188 of Lang corresponds to a base sheet of the present invention and that a transfer roll 190 shown therein corresponds to a receiving and transferring roller of the present invention. However, in Lang, the receiving web 188 is not held on the transfer roll 190, but is instead held on a depositing roll 184 (see Fig. 14 of Lang). The depositing roll 184 in Fig. 14 of Lang corresponds to an applicator roll 14 in Figs. 1 and 4 of Lang, which was acknowledged by the Examiner to correspond to a temporary receiving roller of the present invention. Thus, in Lang, the receiving web 188, which corresponds to the base sheet of the present invention, is not held on the transfer roll

Docket No. F-8984

Ser. No. 10/566,533

190, which corresponds to the receiving and transferring roller of the present invention, but is held on the depositing roll 184, which corresponds to the temporary receiving roller of the present invention.

In the present invention, the base sheet is held on the receiving and transferring roller face, a powder particle layer formed on the temporary receiving roller is transferred onto the base sheet while shifting the powder particle layer held on the temporary receiving roller face, and the powder particle layer is shifted at a shifting speed that is less than a transferring speed of the base sheet. As a result, the powder particle layer being transferred onto the base sheet becomes a linear shape or a blurred pattern in a shifting direction (see page 23, lines 8-16 of the substitute specification).

In stark contrast, the receiving web 12/188 in Lang is not held on the transfer roll 190, but rather is held on the depositing roll 184 (applicator roll 14), and particulate matter 84/180 formed on the depositing/applicator roll 14/184 is transferred onto the receiving web 12/188. Therefore, the particulate matter 84/180 could not possibly be transferred onto the receiving web 12/188 in a linear shape or a blurred pattern, even though the particulate matter 84/180 is shifted at a shifted speed that is less than the speed of the receiving web 12/188.

In Lang, when the particulate matter 84/180 is on the depositing/applicator roll 14/184, the particulate matter 84/180 is sustained by being held in compartments formed on the surface of the depositing/applicator roll 14/184 while being covered

Docket No. F-8984

Ser. No. 10/566,533

with the receiving web 12/188, irrespective of relative speeds of the depositing/applicator roll 14/184 and the receiving web 12/188. According to Lang, when the particulate matter 84/180 is released from the compartments on the depositing/applicator roll 14/184 to be shifted on the receiving web 12/188, the particulate matter 84/180 is formed into predefined discrete piles, regardless of relative speeds of the depositing/applicator roll 14/184 and the receiving web 12/188, because the receiving web 12/188 is held on the depositing/applicator roll 14/184. Thus, in Lang, the particulate matter 84/180 could not be transferred onto the receiving web 12/188 in a liner shape or a blurred pattern, even if the particulate matter 84/180 is shifted at a shifted speed that is less than the speed of the receiving web 12/188.

Applicants further submit that Packard et al. fails to adequately supplement the deficiencies in Lang noted above. Moreover, Lang teaches away from the proffered combination with Packard et al. as argued more fully below.

In Packard et al., a shower of the absorbent particles AP is supplied to the base tissue BT (see Packard et al., col. 5, lines 46-57, and Fig. 1).

On the other hand, in Lang describes that "[t]he invention has the advantage that the superabsorbent or other particle is not released into the air" (see Lang, col. 2, lines 57-59, emphasis added), which clearly discourages an embodiment in which particles are supplied in the form of a shower, like in Packard et al. Accordingly, Lang teaches away from the combination with Packard et al..

Docket No. F-8984

Ser. No. 10/566,533

Applicants additionally respectfully submit that there is no teaching, suggestion or motivation for the combination of Lang with Packard et al.. As discussed above, in Packard et al., a shower of the absorbent particles AP is supplied to the base tissue BT (see Packard et al., col. 5, lines 46-57, Fig. 1).

In contrast, Lang teaches supplying superabsorbent (particular matter) to a groove of an applicator roll 14 face to form a superabsorbent layer, and then transferring the superabsorbent layer to a receiving web 12 to form discrete piles 18 (see Lang, col. 3, lines 2-8, Fig. 1). Therefore, the method for supplying particles of Packard et al., in which a shower form of particles are supplied to a sheet, is completely different from that of Lang, in which a layer form of particles are supplied directly to a sheet. Since the manner of transferring the powder particle layer onto the base sheet according to the method for manufacturing a sheet-shaped body of the present invention is of key importance, one of ordinary skill in the art would not be motivated to combine Lang with Packard et al., since Packard et al. teaches a completely different method for supplying particles from Lang. Accordingly, there is no teaching, suggestion or motivation of combining Lang with Packard et al., at least with the hope and reasonable expectation of success in arriving at the claimed manner of particle deposition according to the claimed invention.

Thus, it is respectfully submitted that the rejected claims are not obvious in view of the cited references for the reasons stated above. Reconsideration of the

Docket No. F-8984

Ser. No. 10/566,533

rejections of claims 1, 2, 5, 17 and 19-21 and their allowance are respectfully requested.

Claims 4 and 15 are rejected as obvious over Lang (US 4,994,053) in view of Packard et al. (US 4,851,069), and further in view of Haubach (US 5,925,439) under 35 U.S.C. §103(a). The applicants herein respectfully traverse these rejections.

Applicants respectfully submit that Haubach fails to provide what is missing in Lang and Packard et al., as discussed above. As such, the proffered combination of references fails to teach or suggest all claimed elements, as properly required for establishing a *prima facie* case of obviousness.

Thus, it is respectfully submitted that the rejected claims are not obvious in view of the cited references for the reasons stated above. Reconsideration of the rejections of claims 4 and 15 and their allowance are respectfully requested.

No fee is believed due. If there is any fee due the USPTO is hereby authorized to charge such fee to Deposit Account No. 10-1250.

Docket No. F-8984

Ser. No. 10/566,533

In light of the foregoing, the application is now believed to be in proper form  
for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,  
JORDAN AND HAMBURG LLP

By Frank J. Jordan by:  
Frank J. Jordan  
Reg. No. 20,456  
Attorney for Applicants  
and,

By Lawrence A. Wechsler  
Lawrence A. Wechsler  
Reg. No. 36,049  
Attorney for Applicants

Jordan and Hamburg LLP  
122 East 42nd Street  
New York, New York 10168  
(212) 986-2340